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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,093	10/04/2000	Shridhar P. Joshi	47079-00064	1828

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JENKENS & GILCHRIST, P.C.
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EXAMINER

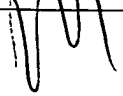
CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/679,093	Applicant(s) JOSHI, SHRIDHAR P. 	
	Examiner Aaron J. Capron	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,29,31-33,35,36,39,46-53,55,100,101 and 103-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,29,31-33,35,36,39,46-53,55,100,101 and 103-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/03</u> . | 6) <input type="checkbox"/> Other: _____ |



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DETAILED ACTION

This is a response to the Amendment received on April 12, 2004, in which claims 26, 35-36, 46 and 100-101 were amended, claims 103-106 were added, and claims 30, 34, 37-38, 54 and 102 were cancelled. Claims 26, 29, 31-33, 35-36, 39, 46-53, 55, 100-101 and 103-106 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Acres (U.S. Patent No. 6,254,483; hereafter "Acres") in view of IGWB New '97 Games (hereafter "IGWB").

Acres discloses a gaming machine comprising a processor for randomly selecting a plurality of outcomes in response to a wager amount, the processor monitoring time signals from a clock; a display for displaying the appearance for a wagering game; a memory device coupled to the processor and storing at least two data sets for producing two different appearances for the gaming machine (3:15-20), the processor automatically selecting one of the at least two data sets primarily in response to the processor monitoring a time signal corresponding to a predetermined time (abstract). It is inherent that all gambling games have a theme/artwork. Most casinos use equivalent gaming machines, but have different artwork to distinguish themselves from their competitors. However, Acres does not specifically disclose the themed artwork being associated

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with a holiday. Acres discloses that background color and card decorations can be reconfigured when in configuration mode. Acres further discloses that the appearance of the game can be altered based upon a societal event such as a holiday. It would be obvious to one of ordinary skill in the art to alter the gaming machine's background colors based upon the time of year of a societal event (for example brown/orange for Halloween and/or red/pink for Valentine's Day) in order to change the manner in which a player perceives the gaming machine. One would be motivated to combine the provide themed artwork correlating to the holiday since Acres discloses altering appearance of the game based upon a predetermined time, the predetermined time being a holiday in order to change the manner in which a player perceives the gaming machine (3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate themed game artwork having a holiday motif into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine. In the alternative, where the interpretation of Acres's appearance does not include thematic game artwork, IGWB discloses the use of reconfiguring the theme of the game machine so that the winning symbols are changed from three sevens to cherries or cabooses (IGWB pages 11, 2-4 full paragraphs) in order to change the manner in which a player perceives the gaming machine. IGWB discloses using character animation to provide enjoyment to the game (Page 17 : The first three paragraphs on page 17 starting with "The entertainment trend...") in order for casinos to distinguish themselves from other casinos and to add extra excitement to the game. One would be motivated to combine the references in order to change the manner in which the player perceives the electronic gaming machine (Acres 3:15-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to incorporate the themed artwork of IGWB into the gaming machine of Acres in order to change the manner in which a player perceives the gaming machine.

Referring to claim 29, Acres discloses using a video display (abstract), such as a video poker machine.

Referring to claim 31, Acres discloses changing the audio and appearance of the machine in response to time (3:15-20).

Referring to claims 32 and 33, Acres discloses a gaming machine that includes the visual elements are associated with the plurality of outcomes (status of the player) and the timing of the game (3:15-20).

Referring to claims 35-36, Acres discloses a gaming machine that includes scheduling/programming for timed events such as one day before a holiday to one day after the holiday (Figure 5).

Referring to claim 39, Acres discloses the clock is internal to the processor.

Referring to claims 46, 52 and 55, as shown above, Acres in view of IGWB disclose the displaying means, the monitoring means and altering the theme/artwork with respect to a known societal event associated with a predetermined time. In addition Acres discloses that card decorations can be altered. Acres further discloses a poker game wherein the cards are visual elements that are selectable by the player and have decorations associated with the second theme and randomly selecting a plurality of outcomes of the gaming machine in response to the wager and the selection of cards that a player is going to keep. After the player picks the cards, the processor assigns additional cards that are not player selectable.

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Referring to claims 47, Acres discloses using an external clock in a hub server (Figures 1, 3 and 5, ref 24).

Referring to claim 48, Acres suggests using a clock that is internal to the processor (5:47-50 and abstract with reference to predetermined changes in variable such as time).

Referring to claims 49 and 51, Acres discloses the steps of displaying include the steps of downloading data corresponding to the game artwork (1:33-57).

Referring to claim 50, Acres discloses using steps to download data from a server (Figures 1, 3 and 5, ref 24).

Referring to claims 53, Acres teaches a game machine programmed to alter game display for timed or calendar events such as holidays (Figure 5).

Claims 100-101 and 103-106 correspond in scope to a gaming system and method set forth for use of the gaming method listed in the claims above and are encompassed by use as set forth in the rejection above.

Response to Arguments

Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive.

Applicant asserts that Acres's teaching on changing the appearance of gaming machine based upon time only limits the gaming machine to change the color(s) of the background. In addition, Applicant completely ignores the fact that Acres asserts changing the appearance of the gaming machine with respect to a predetermined time (abstract, 3:15-20) in order to change the manner in which the player perceives the gaming machine (3:15-16). The term "perceive" is

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defined as to achieve understanding of, apprehend (The American Heritage Dictionary of the English Language, Third Edition copyright 1992). Merely altering the background color and/or the card decoration will not change the manner in which a player perceives the gaming machine as asserted by Applicants in Paper #16, page 11 which states in part “Such background appearance items...do not constitute thematic game artwork”, “For example, background color does not constitute a theme”, “card decoration is, again, merely generic appearance; it does not invoke a theme...even taken together background color and card decoration do not constitute a theme as these elements...to a theme”. In order to alter the appearance of the game machine in a manner in which the player perceives the game, without altering the game itself, the altering must involve the theme of the gaming machine. Changing the perception of the gaming machine would invoke a mental associated with a specific subject matter related to a theme. The changing of the appearance of the game can result in changing of multiple colors or background or elements. Therefore, the claimed invention fails to preclude the invention of Acres.

Applicant asserts that IGWB fails to disclose having animated characters. However, IGWB discloses using character animation to provide enjoyment to the game (Page 17: The first three paragraphs on page 17 starting with “The entertainment trend...” in order for casinos to distinguish themselves from other casinos and to add extra excitement to the game. Therefore, the claimed invention fails to preclude the invention of Acres in view of IGWB.

The basis of Applicant’s invention is merely altering the graphics on a computer display of the gaming machine based upon time. As stated before, Acres asserts altering the appearance of the gaming machine based upon time in manner that would change the way a player perceives the gaming machine. First, the Applicant must ask himself whether a computer display having

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three cherries (or 7's etc) as a graphic is patentably distinct from a computer display having three pumpkins as a graphic. Second, since Acres discloses altering the game appearance of the gaming machine based upon time in a manner that changes how a player perceives the gaming machine, the gaming machine's theme/artwork can only be altered. In essence, Acres alters the gaming machine to change from, for example, blazing cherries to triple 7's. The Examiner fails to see how the combination of the two above would make the present application patentably distinct from the combination of references and therefore, the claimed invention fails to preclude the invention of Acres in view of IGWB.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line extending to the right.

JESSICA HARRISON
PRIMARY EXAMINER